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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,335	11/06/2003	James W. Scott	5490-000366	7916
27572 7590 10/17/2008 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER				
SWIGER III, JAMES L				
ART UNIT		PAPER NUMBER		
3775				
MAIL DATE		DELIVERY MODE		
10/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/702,335

Applicant(s)

SCOTT ET AL.

Examiner

JAMES L. SWIGER III

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8,11,12,14-17,19 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,11,12,14-17,19 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/6/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6, 8, 11-12, 14, 16-17, 19 and 27-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Gundlapalli et al. (US Patent 6,355,045). Gundlapalli et al. disclose an apparatus for preparing the tibia for knee surgery (see Fig. 18) comprising a tibial base (12) having a center axis (between 50 and extending towards cutout 44), a handle (32) having a longitudinal axis (extending approx along 30), and wherein the handle couples to the tibial base or template at only one location. The handle and the tibial base are connected via a link (the area between the tab 56, and the edge of 16) as shown in Fig. 22 and the axes of the base and the handle are co-axial. The handle and base are considered to connect at a periphery location and the base is considered operable to engage and contact a surface of the tibia. The recitation that an element is "operable" to perform a given function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Also, the link, handle, and base are considered integral with one another, and are also considered unitary.

It is noted Gundlapalli et al. disclose the claimed invention except for the handle connecting to the periphery of the tibial base at a location offset which, by default,

defines a clearance area for avoiding tissue impingement when using the device and further makes the device reversible for either a right or left knee surgery. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the tibial preparation apparatus having an offset link between the handle and base, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a better clearance for the surgeon during surgery or to prevent tissue impingement. In re Dailey and Eilers, 149 USPQ 47 (1966).

In addition to the offset handle being an obvious design choice, it is noted that having an offset connection between a head and handle is well-known in the art. As noted previously, Klein (US Patent 1,011,628) discloses a device that has an offset connection but a co-axially aligned handle and head portion. The advantage of this design is that the section A2 allows the measurement device to better fit in the area that it was designed to be used in. In another mechanical example, Stavinski et al. (US Patent 5,906,144) shows a tool with an offset connection or link between a co-axial handle (12) and head portion (18). In this device, the shape is optimized to retain most of its normal functionality (as in a tibial preparation apparatus) but allow it to be advantageous in certain situations when required. Thus, modification of shape between a handle and head portion is well known in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gundlapalli et al. (US Patent 6,355,045). Gundlapalli et al. disclose the claimed

invention except for the linked portion being set from the central axis at angles. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the offset portion at an angle between 15 and 45 degrees to the axis of the base, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art, and as in this case, to provide adequate space between the head and the handle. *In re Aller*, 105 USPQ 233.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-6, 8, 11-12, 14-17, 19 and 27-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES L. SWIGER III whose telephone number is (571)272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES L SWIGER/
Examiner, Art Unit 3775

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733

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